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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,072	02/13/2006	Masaki Ukai	P71118US0	7453
136 7590 06/18/2008 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER REDDY, KARUNA P				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/18/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,072

**Applicant(s)**

UKAI ET AL.

**Examiner**

KARUNA P. REDDY

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 7, 8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 7-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-856)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to amendment filed 4/8/2008. Claims 3-6 and 9 are cancelled; and claim 1 is amended. Claims 1-2, 7-8 and 10-16 are currently pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1-2, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takegawa et al (US 4,386,992).

The rejection is adequately set forth in paragraph 5 of office action mailed 1/10/2008 and is incorporated here by reference.

4. Claims 7-8 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takegawa (US 4,386,992) in view of Nakano et al (US 5,166,229).

The rejection is adequately set forth in paragraph 6 of office action mailed 1/10/2008 and is incorporated here by reference.

### ***Response to Arguments***

5. Applicant's arguments with respect to rejection of claims 1-3 and 12 under 35 U.S.C. 102(b) as being anticipated by Bullman (US 3, 772, 237); claims 10-11 under 35

U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bullman (US 3, 772, 237); claims 7-8 and 13-16 under 35 U.S.C. 103(a) as being unpatentable over Bullman (US 3, 772, 237) in view of Nakano et al (US 5,166,229), have been considered and are persuasive. The rejection of claims 1-3 and 12 under 35 U.S.C. 102(b) as being anticipated by Bullman (US 3, 772, 237); claims 10-11 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bullman (US 3, 772, 237); claims 7-8 and 13-16 under 35 U.S.C. 103(a) as being unpatentable over Bullman (US 3, 772, 237) in view of Nakano et al (US 5,166,229) has been withdrawn.

6. Applicant's arguments filed 4/8/2008 with respect to prior art rejections set forth in paragraphs 5-6 of office action mailed 1/10/2008, have been fully considered but they are not persuasive. Specifically, applicant argues that (A) examiner admits that Takegawa et al fail to disclose a two-pack composition comprising applicant's claimed non-aqueous resin; (B) examiner alleges that because Takegawa et al teach polyacrylates which are generic to core-shell and gradient resins", it would have been obvious to use the resins of applicants in the two-pack curable composition of Takegawa et al; (C) Takegawa et al teach a two-pack adhesive composition comprising an aqueous synthetic resin emulsion adhesive and a gelling agent selected from the group consisting of calcium pantothenate, glycine calcium salt etc.; (D) adhesive of Takegawa et al is an aqueous emulsion adhesive which has the disadvantages like "resistance to showering in a gel state", "causes rusting of metals", "would form bubbles or blisters in the seals and coatings", "elongation cannot be attained", "poor adhesion to treated steel plate". In contrast, the two-pack curable composition is a non-aqueous one; (E) compositions of

Takegawa et al cannot be used as a seam sealing composition claimed by applicants due to the problems caused by their inherent physical properties. Examiner has not made a proper prima facie obviousness rejection because the examiner has not answered why one skilled in the art would have been motivated to look at the teachings of Takegawa et al because of the problems caused by their inherent physical properties; (F) examiner may not combine references in the art unless the prior art suggested the desirability of such a modification or replacement; and (G) one of ordinary skill in the art would have known that epoxy resins would not have been suitable to combine with an aqueous polymer resin, as taught in Takegawa et al, because the epoxy resin would not have been soluble in the aqueous polymer resin

With respect to (A) and (D), it is noted that the features upon which applicant relies (i.e., "non-aqueous resin", "resistance to showering in a gel state", "causes rusting of metals", "would form bubbles or blisters in the seals and coatings", "elongation cannot be attained", and "poor adhesion to treated steel plate") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). While applicant alleges that examiner admitted to the absence of claimed non-aqueous resin, it is noted that examiner referred to the resin as "resin of present claims" and it is clear from the claim language that there is no reference to the resin being "non-aqueous."

With respect to (B), it is noted that polyacrylates and other resins such as polyvinyl chloride and vinylidene chloride copolymer are listed in paragraph 5 of office action mailed 1/10/2008 and is incorporated here by reference.

With respect to (C), applicant's attention is drawn to paragraph 5 of office action mailed 1/10/2008, wherein examiner has indicated that gelling agents include organic solvents such as alcohols and ketones.

With respect to (E), case law holds that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim.

With respect to (F), motivation to combine the prior art references of Takegawa et al and Nakano et al is provided in paragraph 6 of office action mailed 1/10/2008 and is incorporated here by reference. It is held by court that combining prior art elements according to known methods to yield predictable results is prima facie obvious. See KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

With respect to (G), it is noted that present claims do not require epoxy resin to be soluble in the resin. Furthermore, the statement that epoxy resins are not soluble in aqueous polymer resins is a mere conclusory statement without any evidence to support it i.e. attorney's statements are not a substitute for factual evidence.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Contact Information***

Art Unit: 1796

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karuna P Reddy/  
Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/  
Supervisory Patent Examiner, Art Unit 1796